



AF/2613  
11W

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

---

**EX PARTE THOMAS ET AL.**

---

**Application for Patent**

**Filed June 16, 1998**

**Serial No. 09/098,279**

**Group Art Unit 2613**

**Examiner: VO, Tung T.**

**FOR:**

**METHOD AND SYSTEM FOR REMOTE MONITORING AND  
CONTROL OVER A COMPUTER NETWORK**

---

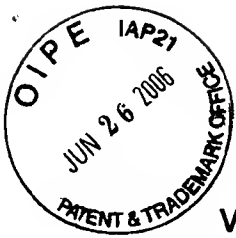
**REPLY BRIEF**

---

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 20, 2006.

Signed: \_\_\_\_\_  
AI Penilla



## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL [Supplemented]**

The issues presented on appeal are:

- A. Claims 1, 2, 4, 5, 7-9, 11-18, 26-31 and 39-48 stand rejected as obvious over Ng (U.S. Patent 5,731,832) in view of Maeno (U.S. Patent 5,283,644).
- B. Claims 1, 2, 4, 5, 7-9, 11-12, 16-18, 26-31 and 39-48 stand rejected as obvious over Ng (U.S. Patent 5,731,832) in view of Parulski et al. (U.S. Patent 6,573,927 B2).
- C. Claims 13-15 stand rejected as obvious over Ng (U.S. Patent 5,731,832) in view of Parulski et al. (U.S. Patent 6,573,927 B2) and further in view of Glatt (U.S. Patent 5,926,209).
- D. Claims 49, 50 and 52-61 stand rejected as obvious over Ng (U.S. Patent 5,731,832) in view of Acosta et al. (U.S. Patent 6,166,729).
- E. Claims 62-66 stand rejected as obvious over Ng (U.S. Patent 5,731,832) in view of Acosta et al. (U.S. Patent 6,166,729) and further in view of Glatt (U.S. Patent 5,926,209).

**From the Examiner's Answer it is not clear whether the rejections associated with Issues C., D. and E above have been withdrawn. Nevertheless, Appellants provided the following supplemental arguments. The following supplemental arguments serve to supplement the Appeal Brief entered February 3, 2006, which also incorporates an earlier Appeal Brief entered May 26, 2005.**

## **VII. ARGUMENT [Supplemented]**

**A. Claims 1, 2, 4, 5, 7-9, 11-18, 26-31 and 39-48 are patentable over Ng (U.S. Patent 5,731,832) in view of Maeno (U.S. Patent 5,283,644).**

### **MAENO DOES NOT TEACH OR SUGGEST ANY USE OF AN ELECTRONIC MAIL MESSAGE**

On page 18 of the Examiner's Answer it is asserted that Maeno teaches automatically creating an electronic mail message having an image included or attached and automatically sending the electronic mail message to a predetermined user at a predetermined mailing address. The Examiner references several portions of Maeno as support for such teachings. Unfortunately, the Examiner is misguided. Maeno lacks any of these teachings. Maeno uses a facsimile transmission and the document consistently and repeatedly clearly states such. At best, Maeno casually mentions:

Although the system has been arranged to send report data including the ID number related data, time data and intruder's face picture model data on a facsimile transmission basis, other suitable transmission technique and medium may be employed. For example, a suitable display unit under control of a computer can be installed even at the side of the report receiver 300 and the report data can be transmitted by an image transmission technique other than the facsimile transmission technique to be displayed on the display unit.

Maeno, col. 10, lines 8-17.

Thus, the system of Maeno has nothing to do with surveillance images and makes no use of an electronic mail message to a predetermined mailing address of an interested user. Nor does Maeno teach or suggest that the predetermined mailing address would be provided during an advance configuration operation.

Therefore, although the Examiner relies on Maeno in view of the serious deficiencies of Ng, Maeno lacks the teaching for which it is being cited. Carefully considered, Maeno: (i) lacks use of electronic mail messages, (ii) lacks use of

advance configuration to provide a predetermined mailing address, and (iii) lacks providing a surveillance image with an electronic mail message when an activity condition is detected.

**ALLEGED MOTIVATION IS EITHER THE PRODUCT  
OF HINDSIGHT OR AN IMPROPER OBVIOUS TO  
TRY REJECTION**

Ng describes a system for detecting motion in a video signal. The system detects motion in a video signal by identifying differences between a current image frame and a reference image frame. A motion detection signal is generated by the system if a difference profile between the current image frame and the reference image frame exceeds a threshold. Upon generation of a motion detection signal, the system may be configured to record the current image frame if the difference profile exceeds the threshold. The modem 28 in Ng is indicated as capable of transmitting a captured image. As such, there is no motivation for one skilled in the art to combine Maeno with Ng. In other words, Ng would not be advanced by combining it with the facsimile transmission of Maeno. There is simply no need or motivation to combine Maeno with Ng as proposed by the Examiner.

Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow all claims rejected in view of Ng and Maeno.

**B. Claims 1, 2, 4, 5, 7-9, 11-12, 16-18, 26-31 and 39-48 are patentable over Ng (U.S. Patent 5,731,832) in view of Parulski et al. (U.S. Patent 6,573,927 B2).**

**PARULSKI ET AL. IS NOT PERTINENT PRIOR ART**

Initially, it should be noted that the Examiner's Answer continues to assert that Parulski et al. is properly combined with Ng. Applicants respectfully disagree.

First, as noted in the Appeal Brief, Parulski et al. is not logically combinable with Ng.

Second, Parulski et al. is not even pertinent prior art. Parulski et al. pertains to an electronic still camera and preparing a print order on a removable memory card. The print order can then be carried out with the memory card is provided to another device, such as a printer, kiosk, photofinisher, etc. Hence, in contrast to the claimed invention, Parulski et al. has nothing to do with acquiring images from surveillance of a building by a general purpose computer, and sending the images to an interested person via an electronic mail message. The problems being solved and the field of endeavor are completely different. Moreover, one skilled in the art of surveillance monitoring would not have reasonably consulted Parulski et al. to modify Ng as proposed by the Examiner. Consequently, it is submitted that Parulski et al. is non-analogous art and this not properly combined with Ng under 35 USC 103.

**PARULSKI ET AL. NOT COMBINABLE WITH NG  
AND DOES NOT TEACH OR SUGGEST ANY USE OF  
AN ELECTRONIC MAIL MESSAGE FOR  
AUTOMATED DELIVERY OF A SURVEILLANCE  
IMAGE WHEN ACTIVITY DETECTED**

First, Parulski et al. captures image with a camera. A user can subsequently select the images of interest and a person who is to receive them. One option is for the user of the camera to create an email order that can

eventually provide images to another via email. This approach, if combined with Ng, would yield image delivery unrelated to the detection of an activity condition. That is, the local user in Parulski et al. must himself select the images to be sent to another. Such an approach would not advantageously be combined with the transmission of an image to a police department described in Ng. Even if these references were to be combined the resulting email delivery would be only after the image are acquired and a user at the surveillance location selects the image to transmit via email.

Second, the sending of images to another in Parulski et al. is not only done by a camera user but also is not automatically performed upon detecting an activity condition. Indeed, Parulski et al. teaches against sending images automatically on detection of an activity condition. That is, in Parulski et al., the images are only later transmitted if, and when, a camera user causes such image distribution through manual interact with the camera and possibly an image distribution station. Parulski et al. also does not detect activity conditions. Hence, the image distribution station of Parulski et al. does not and can not operate automatically to transmit images using an electronic mail message and a predetermined mailing address on detection of an activity condition.

In addition, claim 1 recites “configuring, prior to said receiving, comparing, detecting and notifying, said general purpose computing device so as to automatically notify the interested user via a predetermined mailing address when an activity condition is subsequently detected” (claim 1). Neither Ng nor Parulski et al. teach or suggest a configuring act. Ng does not teach or suggest any use of a predetermined mailing address, as noted by the Examiner. Parulski et al. only mentions electronic mail in the context of a possible option for a camera user (via a camera or an image distribution station), which occurs at user’s direction after image acquisition.

Still further, there is no disclosure, suggestion or motivation of record that would lead one of ordinary skill in the art to combine these references in the manner proposed by the Examiner. Ng concerns detecting motion in video

signals, while Parulski et al. concerns creating a print order for images acquired from a camera and stored to a removable memory card. The respective technologies and problems concerning these references are completely different. Accordingly, it is respectfully submitted that the combination of Ng and Parulski et al. is improper. The combination of the disparate references of Ng and Parulski must be the result of improper hindsight. Such combination is thus tantamount to an improper "obvious to try" rejection.

**EXAMINER HAS NOT ESTABLISHED THAT  
PARULSKI ET AL. IS PRIOR ART**

As noted above, the Examiner rejected all claims under 35 USC §103(a) in view of the combination of Ng and Parulski et al. As explained below, Parulski et al. is not prior art against the present patent application; therefore, each and every rejection under 35 USC §103(a) using Parulski et al. is fatally defective.

The present patent application was filed June 16, 1998 and claimed domestic priority of U.S. Provisional Application No. 60/051,489, filed July 1, 1997. Hence, the effective filing date of the present patent application is July 1, 1997.

Parulski et al., as cited by the Examiner, is U.S. Patent 6,573,927 B2. A U.S. patent can be effective as prior art under 35 USC §102(a) as of its issue date. The issue date of Parulski et al. is June 3, 2003. Since the filing date of the present patent application is well before June 3, 2003, Parulski et al. is unable to qualify as prior art under 35 USC §102(a).

A patent application filed in the United States can qualify as prior art as of its filing date 35 USC §102(e), provided that the patent application issues into a patent. Parulski et al. was filed November 24, 1997 and thus "on its face" fails to qualify as prior art 35 USC §102(e) against the present patent application. Also, while Parulski et al. does claim priority to an earlier provisional application, the Examiner makes no assertions that this provisional filing supports an earlier prior art date for Parulski et al. 35 USC §102(e).

Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow all claims rejected in view of Ng and Parulski et al.

**C. Claims 13-15 are patentable over Ng (U.S. Patent 5,731,832) in view of Parulski et al. (U.S. Patent 6,573,927 B2) and further in view of Glatt (U.S. Patent 5,926,209).**

Claims 13 -15 recite use of a motion detector in conjunction with the local camera and the local general purpose computer recited in claim 8. According to claim 13, "said local general purpose computer receives the motion indication signal and determines whether an activity condition is present based on the motion indication signal." The Examiner admits on page 13 of the Examiner's Answer that both Ng and Parulski et al. are deficient in teaching such a motion detector or its usage. To overcome this deficiency, the Examiner relies on Glatt. Glatt describes a video camera apparatus with a compression system responsive to video camera adjustment. In FIG. 4 of Glatt, as referenced by the Examiner, the camera module 240 includes a motion detector 216. However, as noted and column 7, line 59-62, the motion detector 260 "analyzes video image signals 244 output by camera 242 to determine whether the subject of the surveillance by camera 242 has moved. This type of motion detection is in general similar to the motion detection utilized in Ng – merely analyzing images. Hence, Glatt suffers from the same fatal deficiency as does Ng. The motion detector recited in claim 13 is part of the system recited in claim 8, and thus is a physical detector separate and apart from a camera. Indeed, claims 13-15 further detail that the motion detector produces a motion indication signal that is supplied to the local general purpose computer, that the motion detector and the camera are directed

at the same location from approximately the same direction, and that a motion detector is mounted on the camera.

Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow all claims rejected in view of Ng, Parulski et al. and Glatt.

**D. Claims 49, 50 and 52-61 are patentable over Ng (U.S. Patent 5,731,832) in view of Acosta et al. (U.S. Patent 6,166,729).**

#### **NO MOTIVATION TO COMBINE**

Ng describes a system that detects motion in a video signal. Acosta et al. describes a remote digital image viewing system and method. The system renders digital images available for download over a network. Hence, Acosta et al. has nothing to do with a surveillance system such as Ng. Further, Ng is able to transmit an image upon detection of an activity condition to a police station. Hence, there is no motivation for one skilled in the art to utilize the remote digital image viewing system of Acosta et al. with Ng. On page 16 of the Examiner's answer, the Examiner's sparse justification for the combination would be that the user can access images over the Internet. However, as noted, Ng has no need or desire to facilitate Internet access to acquired images. Indeed, such Internet access to the images acquired in Ng would be counter productive since the image is associated with motion detection can trigger a direct communication to a police station in a more efficient manner. Accordingly, it is submitted that there is no adequate motivation of record to combine Acosta et al. with Ng.

### **NO PRIMA FACIE REJECTION FOR CLAIMS 50, 52, 54-61**

As to the rejection of claims 50, 52 and 54-61, it is submitted that the Examiner has failed to make a *prima facie* rejection. In this regard, the Examiner did not specifically comment on the limitations recited in these claims. As such, the rejection of these claims under 35 USC 103 are defective.

Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow all claims rejected in view of Ng and Acosta et al.

**E. Claims 62-66 stand are patentable over Ng (U.S. Patent 5,731,832) in view of Acosta et al. (U.S. Patent 6,166,729) and further in view of Glatt (U.S. Patent 5,926,209).**

Claims 62-66 depend from independent claim 58. As noted above, the Examiner has failed to make out a *prima facie* rejection as to claim 58. Consequently, it is also submitted that the Examiner has necessarily failed to make out a *prima facie* rejection is to claim 62-66. While the Examiner has cited Glatt for the purpose of a motion detector. As explained above, Glatt lacks any adequate teaching for a motion detector as recited in claims 62 and 63. Additionally, as to claims 64-66, the Examiner has again failed to make a *prima facie* rejection. For example, the Examiner has not commented anywhere as to various limitations recited in these claims, such as a security system having at least one sensor.


Accordingly, it is respectfully requested that the Board reverse the Examiner's rejections and remand the application to the Examiner with directions to allow all claims rejected in view of Ng, Acosta et al. and Glatt.

## CONCLUSION

For at least the reasons set forth in the Appeal Brief and in this Reply Brief, the Board should reverse the Final Rejection and should order the Examiner to pass this application to allowance.

If any additional fees are required in connection with the filing of this Supplemental Appeal Brief, the Commissioner is authorized to charged Deposit Account No. 50-0805 (Order No. ATC1P001).

Respectfully Submitted,

  
Albert S. Penilla, Esq.  
Reg. No. 39,487

(408) 749-6903